

## **REMARKS/ARGUMENTS**

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

### **I. STATUS OF THE CLAIMS AND FORMAL MATTERS**

Claims 1-3, 5-8 and 10-14 are currently pending. Claims 4 and 9 are hereby canceled. Claims 1, 6 and 11-14 are independent. Claims 1, 6, 11 and 13 are hereby amended. No new matter has been introduced. Support for this amendment is provided throughout the Specification as originally filed.

Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

### **II. TELEPHONE INTERVIEW**

Applicant's representative thanks the Examiner for granting the telephone interview on January 8, 2007. Applicant's representative explained that claim 1 provided two distinct time periods in which different processing was performed. During a predetermined time period specified by a later-stage processor, retry processing is performed in an attempt to retrieve accurate data. After the predetermined time period elapses, dummy data is provided if accurate data can not be retrieved. The Examiner suggested the separate processing in each of two

distinct time periods could be clarified. However, no agreement was reached on claim language to overcome the cited references.

### III. REJECTIONS UNDER 35 U.S.C. §103

- Claims 1-3, 5, 11 and 13 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 5,604,646 to Yamawaki in view of U.S. Patent No. 6,621,979 to Eerenberg et al. (herein after, merely “Eerenberg”).

Applicants respectfully traverse this rejection.

Independent claim 1 is representative and recites, *inter alia*:

“ . . . during the predetermined period of time, the error correction means performs retry processing to correct a bit error when said error correction means detects a bit error difficult to correct, and  
...  
... when the predetermined period of time has elapsed, the error correction means substitutes recognizable dummy data for said playback data output to said later-stage processing when said error correction means detects a bit error difficult to correct.” (emphases added)

As understood by the Applicants, Yamawaki discloses, in relevant part, a data error correcting method for a disk accessing apparatus that transfers target data that follows a sync pattern to a speed matching buffer. The target data is transferred to a buffer memory and subjected to an error correction operation. When detection of a sync pattern is unsuccessful, dummy data is supplied directly to the buffer memory in place of the undetected target data. Abstract. The dummy data is then subjected to the error correction operation. Col. 5, lines 19-24.

In contrast, claim 1 recites, “. . . during the predetermined period of time . . . performs retry processing to correct a bit error . . . and, when the predetermined period of time has elapsed, the error correction means substitutes recognizable dummy data for said playback data output to said later-stage processing when said error correction means detects a bit error difficult to correct.”

That is, there are two periods of time addressed in the embodiment of claim 1. During the predetermined time period for playback of the data, the apparatus of claim 1 performs retry processing in an attempt to recover from a detected bit error. After the predetermined time period elapses, the apparatus of claim 1 substitutes the recognizable dummy data for the playback data.

Thus, after the time period specified by the later-stage processor, data is provided to later-stage processor whether such data is correct or not. That is, the contiguity of supply of the playback data has precedence over the reliability of the playback data. Contiguity of data from the recording medium is taken into consideration more than data reliability. That is, a higher priority is given to continuity of playback data over reliability of the playback data by limiting the retry and alternative processing. Pub. Appl. pars. [0005]-[0007].

Yamawaki does not receive a time constraint from a later-stage processor along with the request for playback data and then does not invoke that time constraint to provide data, reliable or not. Moreover, Yamawaki also does not predicate supply of the dummy data on a time period provided by the later-stage processor.

The Office Action (at page 3, 3<sup>rd</sup> bullet) points to Yamawaki col. 9, lines 27-30 for the feature of performing retry processing during the predetermined time period. However, at that

location Yamawaki discusses writing dummy data into the buffer memory. The Office Action (at page 3, 4<sup>th</sup> bullet) points to Yamawaki col. 5, lines 19-23 for the feature of substituting dummy data after the predetermined time period has elapsed. Thus, the Office Action is asserting Yamawaki is writing dummy data to the buffer in both time periods.

That is, Yamawaki does not describe two time intervals: (1) the predetermined time period (specified by the later-stage processor) in which retry processing is performed, and (2) after the predetermined time period has elapsed providing dummy data. Yamawaki describes the supplying of dummy data based upon the event of missing a sync signal.

Eerenberg does not add the elements missing from Yamawaki.

Thus, claim 1 is patentable over Yamawaki and Eerenberg because those references taken alone or in combination do not disclose, teach or suggest each and every limitation recited in the claim.

For reasons similar or somewhat similar to those described above with regard to independent claim 1, independent claims 6 and 11-14 are also believed to be patentable.

- Claims 6-10 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Yamawaki in view of U.S. Patent No. 6,222,693 to Aoki et al. (herein after, merely “Aoki”); and
- Claims 12 and 14 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Yamawaki in view of Eerenberg and further in view of Aoki.

Applicants respectfully traverse these rejections for at least two reasons:

First, claims 6-10, 12, and 14 include elements substantially the same as discussed herein above with regard to claim 1 and are believed allowable for at least the same reasons.

Second, Aoki is disqualified as prior art under 35 U.S.C. 103(c)

While the Applicants disagree with the merits of the rejection of claims 6-10, 12, and 14 over Yamawaki, Eernberg and Aoki, this argument is moot because the Aoki reference is ineligible as prior art against the applicants' claims under 35 U.S.C. 103(c), which states:

(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. (emphasis added)

Under 35 U.S.C. 103(c), an applicant's admission that subject matter was developed prior to applicant's invention would not make the subject matter prior art to applicant if the subject matter qualifies as prior art only under sections 35 U.S.C. 102(e), (f), or (g), and if the subject matter and the claimed invention were commonly owned at the time the invention was made. *See* MPEP 706.02(1)(2), section I.

Under 35 U.S.C. 103(c), the Aoki application qualifies only as prior art under 35 U.S.C. 102(e) but not under 102(a) or 102(b):

Aoki is 102(e) prior art because Aoki's U.S. filing date of January 24, 1996 is earlier than the present application's foreign priority date of June 14, 2000.

Aoki is not 102(b) prior art because Aoki's publication date of April 24, 2001 is not more than 1 year before the present application's U.S. filing date of June 13, 2001.

Aoki is not 102(a) prior art because Aoki's publication date of April 24, 2001 is after the present application's foreign priority date of June 14, 2000.

The Aoki application only qualifies as prior art under 35 U.S.C. 102(e). Thus, under 35 U.S.C. 103(c), the Aoki reference will not preclude patentability of the present application if Aoki and the present application were commonly owned. The standard for what constitutes a proper statement of common ownership is described in MPEP 706.02(l)(2), section II.<sup>1</sup> As such, the applicants' representative states that:

#### STATEMENT OF COMMON OWNERSHIP

U.S. Application Serial No. 08/590,487 of Aoki et al. was, at the time the invention of U.S. Application Serial No. 09/880,445 of Nishimura was made, commonly owned by SONY Corporation. (See Assignments: Reel/Frame: 007959/0704 for Aoki et al. and 012164/0557 for Nishimura).

Therefore, the Aoki application must be removed from consideration for the rejection of claims 6-10, 12 and 14.

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<sup>1</sup> "The statement concerning common ownership should be clear and conspicuous (e.g., on a separate piece of paper or in a separately labeled section) in order to ensure that the examiner quickly notices the statement. Applicants may, **but are not required to**, submit further evidence, such as assignment records, affidavits or declarations by the common owner, or court decisions, *in addition to* the above-mentioned statement concerning common ownership.

For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f), and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

"Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z."

**This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X."**

#### IV. DEPENDENT CLAIMS

The other claims are dependent from one of the claims discussed above and are therefore believed patentable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

#### CONCLUSION

Claims 1-3, 5-8 and 10-14 are in condition for allowance. In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited reference, or references, it is respectfully requested that the Examiner specifically indicate those portions of the reference, or references, providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,

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